REMARKS

In response to the above-identified Office Action, Applicants do not amend any claims, cancel any claims or add any new claims. Accordingly, claims 35-49, and 53-56 are pending.

I. **Claims Rejected Under 35 U.S.C. § 102**

Claims 35, 37, 38, 39, 40, 42-44, 47 and 56 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,347,225 issued to Nishiyama (hereinafter "Nishiyama"). Applicants respectfully disagree for the following reasons.

It is axiomatic that in order to anticipate a claim the Examiner musts show that a single reference teaches each element of a claim. In regard to claims 35, 44 and 47, these claims include the elements of initiating a transmission mode based on user input, autoselecting a form based on displayed content and displaying previously requested data on a display. Nishiyama does not teach each of these elements of claims 35, 44 and 47. Rather, as Applicants argued in the previous Response to Office Action, mailed March 27, 2003, Nishiyama teaches generating an "automatic" response based on the source of an incoming call using the telephone number of the incoming call to identify the source. See Abstract, Nishiyama. Nishiyama explicitly states that it is an object of its invention to "provide a radio telephone system in which plural response messages are stored in a telephone set for a callee who may be absent at a time of receiving a call." See Nishiyama, col. 1, lines 51-55. Thus, Nishiyama teaches a system of pre-categorizing incoming telephone numbers and associating them with predetermined responses so as to avoid the need for human intervention in the response process. One of ordinary skill in the art would understand that Nishiyama teaches a system where human intervention is not a part of the automatic response process.

The Examiner has not indicated and Applicants have been unable to discern any part of Nishiyama that teaches initiating a transmission mode based on user input, autoselecting a form based on displayed content or displaying previously requested data. Rather, the Examiner argues that the response messages of Nishiyama are automatically transmitted to a caller and that user

input is involved in programing the telephone. See page 3, Paper No. 16. However, this is not equivalent to the initiating of a transmission mode based on user input as claimed in claims 35, 44 and 47. The user input relied upon by the Examiner is user input that is unrelated to initiating a transmission mode. The user input of programming a telephone does not cause a transmission mode to be initiated. Rather, it simply stores information for later use by the telephone when the incoming call is received.

Similarly, the Examiner argues that sending a formatted response message in response to incoming calls is equivalent to autoselecting a form based on displayed content. See page 3, Paper No. 16. As has been set forth by the Applicant in the previous Response to Office Action, a form is a "document with blanks for the insertion of details or information." The *American Heritage Dictionary of the English Language*, 4th Edition, 2000, Houghton Mifflin. The message that is sent by Nishiyama in response to incoming calls is a complete message that is not generated using a blank form by insertion of detailed information as claimed in claims 35, 44 and 47. Thus, the Examiner has failed to establish that Nishiyama teaches each of the elements of claims 35, 44 and 47 because Nishiyama does not reach initiating transmission mode based on user input or auto selecting a form based on a displayed content because it does not teach a system where user interaction plays a part in generating a response message to an incoming call.

Further, the Examiner has not identified and Applicants have been unable to discern any part of Nishiyama that teaches the reception of previously requested data as claimed in claims 35, 44 and 47. Thus, Nishiyama does not teach displaying previously requested data as claimed in claims 35, 44, and 47. Therefore, the Examiner has failed to establish that Nishiyama teaches each of the elements of claims 35, 44 and 47. Accordingly, reconsideration and withdrawal of the anticipation rejection of claims 35, 44, and 47 are requested.

In regard to claims 37 and 43, these claims depend from independent claim 35 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to the claim

35 above, these claims are not anticipated by <u>Nishiyama</u>. Accordingly, reconsideration and withdrawal of the anticipation rejection of claims 35 and 43 are requested.

In regard to claim 38, this claim includes many of the elements of claims 35, 44, and 47. Specifically, claim 38 includes the elements of automatically entering a mode for a user to transmit a message. As set forth above in regard to claims 35, 44 and 47, <u>Nishiyama</u> does not teach a system where a user is involved in generating a message in response to detecting predetermined content as claimed in claim 38. Rather, <u>Nishiyama</u> teaches a system where preset messages are automatically sent in response to receiving a call from a specific telephone number without the intervention of a user. Therefore, <u>Nishiyama</u> does not teach each of the elements of claim 38. Accordingly, reconsideration and withdrawal of the anticipation rejection of claim 38 are requested.

In regard to claims 39 and 42, these claims depend from independent claim 38 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 38, these claims are not anticipated by <u>Nishiyama</u>.

In regard to claim 56, this claim includes many of the elements of claims 35, 44 and 47. Specifically, claim 56 includes the elements of entering a transmission mode for allowing a user to transmit electronic message in response to detecting predetermined content. For the reasons set forth above in regard to claims 35, 44 and 47, <u>Nishiyama</u> does not teach entering a transmission mode for allowing a user to transmit a message in response to detecting predetermined content. Rather, <u>Nishiyama</u> teaches a system where user input is not involved in the generation of a response message. Further, this claim includes the element of transmitting an electronic mail message. The Examiner admits on page 4 of Paper No. 16, that <u>Nishiyama</u> does not teach a phone having email capabilities. Thus, <u>Nishiyama</u> does not teach each of the elements of claim 56. Accordingly, reconsideration and withdrawal of the anticipation rejection of claim 56 are requested.

II. Claims Rejected Under 35 U.S.C. § 103

Claims 36, 41, 45, 46, 48, 49 and 53-55 stand rejected under 35 U.S.C. §103 as being unpatentable over Nishiyama in view of U.S. Patent No. 5,875,403 issued to Christal (hereinafter "Christal"). Applicants respectfully disagree for the following reasons.

In order to establish a *prima facie* case of obviousness, the Examiner must show that the cited references combined teach or suggest each of the elements of the claims. In regard to claims 36, 41, 45, 46, 48 and 49, these claims depend from independent claims 35, 38, 44 and 47 and include the limitation thereof. Thus, for the reasons set forth above in regard to the independent claims, Nishiyama does not teach each of the elements of claims 36, 41, 45, 46, 48 and 49. Christal does not cure the defects of Nishiyama. Christal teaches a device set that provides two options for responding to SMS messages. The first option for responding to SMS messages taught by Christal is to send back a preset "YES" message when viewing a message by pressing sequentially an "OPTION" button, a "YES" button, and finally a "SEND" button to send the message. See Christal, col. 2, lines 29-34 and Figure 4. A second option while viewing received messages is to press the "OPTION" button and then depress an "EDIT" button which opens an editor that allows the creation of a return message using a key pad and then the message can be sent by pressing the "SEND" button. See Christal, col. 2, lines 34-47. Neither of these two manners of responding to a message taught by Christal involve the automatic selection of a form for a message to be transmitted based on the content of displayed information at the time the transmission mode was initiated by user input. All the contents of the message generated for the reply taught by Christal are the result of direct user selection (i.e., sending a "YES" message by pressing a sequence of buttons or composing a message on a keypad). Thus, Christal does not teach an automated selection of a form based on the content of displayed information. Nishiyama combined with Christal does not teach or suggest each of the elements of claims 35, 44 and 47. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 36, 41, 45, 46, 48 and 49. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

In regard to independent claim 53, this claim includes the elements of automatically entering a transmission mode for allowing a user to transmit an electronic mail message from a telephone. As discussed above, in regard to claims 35, 44 and 47, <u>Nishiyama</u> does not teach initiating a transmission mode based upon user input. Thus, <u>Nishiyama</u> does not teach a means for allowing a user to transmit electronic mail message as claimed in claim 53. The Examiner seeks improperly to combine <u>Nishiyama</u> with <u>Christal</u> in order to teach the elements of claim 53. As set forth above in regard to claims 35, 44 and 47, <u>Nishiyama</u> teaches a system to send an automatic response upon receiving a telephone call from a specific user without the intervention of that user. Combining <u>Christal</u> with <u>Nishiyama</u> to allow a user to transmit an electronic mail message from a telephone changes the operating principle of <u>Nishiyama</u> by requiring a user to interact with the system in order to generate a response message in the form of an electronic mail message in response to detecting a predetermined content. See MPEP § 2143 and *In re Ratti*, 270 F.2d 10 (CCPA 1959). Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for client 53. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 53 are requested.

In regard to claims 54 and 55, these claims depend from independent claim 53 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to independent claim 53, these claims are not taught by <u>Nishiyama</u>. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 54 and 55 are requested.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 35-49

and 53-56 patentably define the subject invention over the prior art of record, and are in condition

for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner

believes that a telephone conference would be useful in moving the application forward to

allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

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Dated: _____9/17_____, 2003

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CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 17, 2003.

9-17-03

Lillian E. Rodriguez   September 17, 2003